

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's arguments/amendments with respect to pending claims filed on 12/31/2009 regarding the claim rejection under 35 USC 102 for claim 1 have been fully considered and are persuasive. Therefore the FINAL rejection issued 9/4/2009 has been withdrawn. The Examiner would like to point out that this action is made non-final.
2. As directed by the amendment filed on 12/31/2009: claim 1 has been amended and claims 8, 12, 14 and 17 have been cancelled. Thus, claims 1, 2, 4-7, 9-11, 13, 15, 16 and 18-20 are presently pending in this application.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 9-11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrillo (US Statutory invention Registration H001050) in view of Kobayashi (US Patent 4,819,939), further in view of Kwitek (US Patent 6,447,190).
5. In re Claim 1, Petrillo discloses a barrel for a writing implement, comprising: a barrel body 52 (Fig. 3; Column 3, Line 55) having a gripping part 62 ("support member"; Fig. 3; Column 3, line 56); and a grip member 72/78 (Fig.'s 3-4) of layered structure

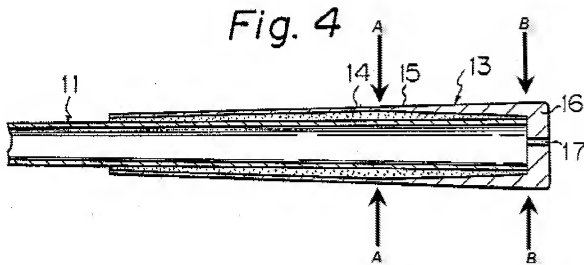
formed by assembling an inner member 72 ("resilient tube"; Fig.'s 3-4; Column 4, line 19) of a soft material and an outer member 78 ("tubular sleeve"; Fig.'s 3-4; Column 4, Line 26), the grip member being disposed on the gripping part of the barrel body (See Fig. 4), wherein the inner member is covered with the outer member (See Fig. 4), and the grip member is formed in an assembly facilitating shape for facilitating putting the outer member on the inner member (it being understood that the grip member is formed in an "assembly facilitating shape" as it is capable of being so assembled), wherein each of the inner member and the outer member is formed prior to putting the outer member on the inner member such that each of the inner member and the outer member constitutes a preformed member (Column 4, Lines 24-28), and wherein the inside diameter of the outer member is greater than the outside diameter of the inner member (See Fig. 4).

6. Although Petrillo does not disclose the assembly facilitating shape being a tapered configuration, attention is directed to Kobayashi (US Patent 4,819,939) which teaches a layered gripping member comprising an inner member 14 (Fig. 4; Abstract) and an outer member 15 (Fig. 4; Abstract), formed in an assembly facilitating shape, wherein the assembly facilitating shape is a tapered configuration, the inner member being tapered from a back part thereof to a front part thereof (See Annotated Fig. 4 below; the inner member having a tapering outer surface diameter along the length defined by "A-B") and the outer member being tapered from a front part thereof to a back part thereof (See Annotated Fig. 4 below; the outer member having a tapering

inner surface diameter along the length defined by "A-B"), for the purpose of providing a dual-layer grip wherein the outer layer is detachably fixed to the inner layer (Abstract).

7. Although Petrillo does not expressly disclose the outer member being axially compressed when put on the barrel body, attention is directed to Kwitek which teaches dual layer gripping member having an inner member and an outer member, wherein the outer member 136 (Fig. 3) is axially compressed when put on the barrel body (Column 4, lines 47-50), for the purpose of providing a structure capable of retaining the outer member on the barrel body (Column 4, Lines 45-50).

8. Accordingly, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Petrillo such that, the assembly facilitating shape is a tapered configuration, the inner member being tapered from a back part thereof to a front part thereof and the outer member being tapered from a front part thereof to a back part thereof, as taught by Kobayashi, and such that the outer member is axially compressed when put on the tip part of the barrel body, as taught by Kwitek, for the purpose of providing a dual-layer grip wherein the outer layer is detachably fixed to the inner layer along with a suitable structure capable of retaining the outer member on the barrel body.



9. In re Claims 2, 4 and 11, Kobayashi further discloses the assembly facilitating shape is a protruding and depressed shape. It being understood by the Examiner that a "tapering orientation", as disclosed by Kobayashi, includes both protruding (i.e. – the larger end of the taper) and depressed (i.e. – the smaller end of the taper) shapes; and the outer member 15 (Fig. 4) is put on the inner member 14 (fig. 4) so as to be separable from the inner member and the barrel body ("detachable fixed"; Abstract).

10. In re Claim 9, Petrillo further discloses the outer member 78 (Fig.'s 3-4) is provided with a radially inwardly extending protrusion (See Fig. 4) at the front part thereof, and wherein a back end surface of the protrusion is in contact with the front end surface of the inner member 72 (See Fig. 4).

11. In re Claim 10, although Petrillo does not disclose the outer member having a mean wall thickness within the specifically claimed range, it is the Examiner's opinion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the outer member with a wall thickness lying within the

range of 1-5 mm, for the purpose of choosing an optimal wall thickness which would permit the outer member to have a desired flexibility, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

12. In re Claim 21, Kobayashi further discloses the front part of the outer member 15 (Fig. 4) circumscribes the front part of the inner member 14 (Fig. 4) and the back part of the outer member circumscribes the back part of the inner member such that the inner member and the outer member are tapered in opposite directions (See Annotated Fig. 4 above, the "front parts" being adjacent to point 'A' and the "back parts" being adjacent to point 'B').

13. Claims 5-7, 13, 15, 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrillo in view of Kobayashi, in view of Kwitek, further in view of Siegel (US Patent 3,250,033).

14. In re Claims 5, 13 and 15, although Petrillo does not disclose the outer member being transparent and the inner member being colored, attention is directed to Siegel which teaches a dual-layered gripping member wherein the outer member 23 ("sleeve"; Fig. 1) is transparent (Column 2, Lines 13-14) and the inner member 20/22 ("slotted sleeve and insert"; Fig. 1) is colored in a color different from that of the outer member (Column 2, Lines 1-12), for the purpose of providing a gripping member which is capable of displaying an advertisement, slogan or message (Column 2, Lines 1-2).

15. Accordingly, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Petrillo such that the outer member is transparent or semitransparent and the inner member is colored in a color different from that of the outer member, as taught by Siegel, for the purpose of enabling the gripping member to be used to display a advertisement, slogan or message.

16. In re Claims 6, 7, 16 and 18-20, Siegel further discloses the inner member and the outer member may be made of materials of different hardnesses, respectively ("plastic" and "glass" respectively; Column 2, Lines 27-34), the inner member being made of a soft material having a low hardness ("plastic"), and the outer member being made of a soft material having a high hardness ("glass"); wherein the inside surface of the outer member is glossy (it being understood that the surface of glass is glossy), for the purpose of constructing the gripping member of materials which will provide the desired visual characteristics and gripping surface (Column 1, Lines 9- 18).

### ***Response to Arguments***

17. Applicant's arguments with respect to claims have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. VARNUM whose telephone number is (571) 270-7853. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. V./  
Examiner, Art Unit 3751

/Huyen Le/  
Primary Examiner, Art Unit 3751